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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,165	08/04/2006	Karl Heinz Schmid	C 2869 PCT/US	9073
23657	7590	07/12/2010	EXAMINER	
FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			NOTIFICATION DATE	DELIVERY MODE
			07/12/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary	Application No. 10/553,165	Applicant(s) SCHMID ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-21 and 23-36 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2005;10/01/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of election filed on 4/26/10 and IDS filed on 10/1/09 and 10/14/05. Claims 14-36 are pending in the application.

Election/Restrictions

Based upon applicants' remarks and claims, lack of unity between groups I and II is hereby withdrawn. Election of species is also hereby withdrawn. Claims 14-36 are examined in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 lacks antecedent basis since hydrogenation converts all the double bonds of the olefin and thus the cosmetic composition does not contain the claimed oligo- α -olefin.

Claim 21 lacks antecedent basis since claim 19 is drawn to linear α -olefin and not branched α -olefin.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 14-18 , 23-26 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,464, 967 ('967).

Claims are drawn to composition comprising branched oligo- α -olefin obtained by oligomerization... in presence of catalyst. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985).

See examples 1-3 drawn to PERFORMA V® 260. See col.2, ll 50-56 of patent '967 which teaches that patent 4,060,569 describe these poly olefins. Patent '569 at col.3, ll 60-68 describes α olefin prepared from linear α -olefin like 1-hexene, 1-octene and 1-decene (claim 14) , branched α -olefins like 3-methyl decene-1 (claim 15), and α -olefins with a vinylidene structure and patent discloses R being alkyl from 4-50 carbon atoms, which can be linear or branched (claim 16).

The patentability of a product does not depend on the method of production, but rather on the product itself (in this case, the poly- α -olefin product), the composition disclosed by patent '967 anticipates the composition recited in instant claim 14. See MPEP 2113. The material disclosed by patent '967 is prepared from monomers with only one olefin, the product disclosed by patent '967 will not have olefins present (the olefin reacts during polymerization), and would be unchanged by hydrogenation (claim 17). The compositions disclosed by patent further can comprise surfactants (column 5, lines 29-33). Example 1 is an emulsion since examples 1 has

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cream consistency. Creams are emulsions and has 11.4 wt% of a polyolefin wax (claims 23-24) and 5.8 wt% of the non-ionic surfactant stearic acid (claim 26).

Claims 14, 19 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,133,209 ('209).

Claims are drawn to composition comprising branched oligo- α -olefin obtained by oligomerization... in presence of catalyst. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985).

Claims recite only the olefin without second component and the preamble of claim 14 and 36 does not carry any patentable weight.

See example 1 drawn to oligobut-1-ene. This reads on claims 14, 19 and 36. It is recognized that the claims are drawn to compositions and the preamble does not carry any patentable weight. Additionally the claims only have the product without any second component.

Claims 14-16, 20-21 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 3,806,470 ('470).

Claims are drawn to composition comprising branched oligo- α -olefin obtained by oligomerization... in presence of catalyst. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

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product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985).

Claims recite only the olefin without second component and the preamble of claim 14 and 36 does not carry any patentable weight.

See col.7, ll 14-18 for the following olefins. See below.

By the term "olefin" as used herein is meant the open- 10
chain as well as cyclic olefins. Among the many olefinic
compounds which may be utilized in accordance with the
process of the invention, the following compounds are
illustrative; propylene, butene-1, butene-2, isobutylene,
pentene-1, pentene-2, 3-methylbutene-1, 2-methyl-butene- 15
2, hexene-1, hexene-2, 4-methyl pentene-1, 3,3-dimethyl-
butene-1, 4-methyl-pentene-2, octene-1, cyclopentene, cy-
clohexene, 3-methyl-cyclohexene, etc

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-18 and 23-36 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 4,919, 934 ('934) and 6,464, 967 ('967)

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Patent '934 teaches deodorant or antiperspirant compositions at col.1, ll 5-10. Patent '934 also teaches poly alpha olefins at col.3, ll 40-68. the alkyl in the poly olefins is 20-40 and not the claimed alkyl range claimed in the instant application. Patent also teaches antiperspirant active at col.6, line 26 through col.7 line 41. Patent '934 at col.9, line 19 through col.10 line 9 teaches emulsifiers and these are claimed in the instant application as surface active agents. The difference between the patent and instant application is patent does not teach the claimed olefins having lower alkyl range.

Patent '967 teaches cosmetic compositions comprising poly alpha olefin. Patent teaches poly alpha olefins in the form of emulsions. Patent '967 at col.2, ll 33-55 teaches poly alpha olefins and teaches that R can denote alkyl radical having 10 -50 carbon atoms. See the abstract. See examples 1-3 drawn to PERFORMA V® 260. See col.2, ll 50-56 of patent '967 which teaches that patent 4,060,569 ('569) describe these poly olefins. Patent '569 at col.3, ll 60-68 describes α olefin prepared from linear α -olefin like 1-hexene, 1-octene and 1-decene (claim 14), branched α -olefins like 3-methyl decene-1 (claim 15), and α -olefins with a vinylidene structure and patent discloses R being alkyl from 4-50 carbon atoms, which can be linear or branched (claim 16).

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare cosmetic sticks in the form of deodorant and antiperspirant using antiperspirant active taught by patent '934 and substitute the poly olefin of patent '934 with poly olefin of patent '967 which teaches that these poly olefins can be used in cosmetic compositions in the form of emulsions and the poly olefins can be linear olefins or branched olefins since patent '967 under examples teaches poly olefin which is mixture of linear olefin and branched

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olefin. One of ordinary skill in the cosmetic art would be motivated to substitute the poly olefin of patent '934 with poly olefin of patent '967 with the reasonable expectation of success that the deodorant compositions or antiperspirant compositions have cream consistency and it is easier to apply on the skin. This is a prima facie case of obviousness.

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619